



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

08/859,995

MA

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/859,995 05/21/97 HEMPLEMAN

J

LM02/0619

DRESSLER ROCKEY MILNAMOW AND KATZ
TWO PURDENTIAL PLAZA
SUITE 4700
180 NORTH STETSON AVENUE
CHICAGO IL 60601

EXAMINER

KINDRED, A

ART UNIT	PAPER NUMBER
----------	--------------

2776

4

DATE MAILED 6/19/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/859,995

Applicant(s)

Hempleman et al.

Examiner

Kindred

Group Art Unit

2776



☒ Responsive to communication(s) filed on 5-21-97

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-29 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2776

DETAILED ACTION

1. This action is responsive to communications: application, filed on 05/21/97.
2. Claims 1-29 are pending. Claims 1, 10, 20 and 25 are independent claims.
3. The present title of the application is "List building system."

Title

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Art Unit: 2776

6. Claims 1-29 are rejected under 35 U.S.C. 102(e) as being unpatentable over Hickey, U.S. Patent Number 5,475,835, filed 03/1993, class 395/600, title “Audio-visual inventory and playback control system.”

With respect to independent claim 1, Hickey discloses “a visual output device” (“display on said touch-screen display means . . .”--column 33, line 16) “circuitry, coupled to the source and the output device, for building a stored inventory of works and for creating a displayable list of titles on the output device of at least some to the works” (“display of said media inventory . . . list of selections . . .”--column 33, line 5).

With respect to dependent claim 2, Hickey discloses “includes an audio output device coupled to the building circuitry and playback circuitry for presenting to the audio output device an output corresponding to the titles on the list” (“play/record main menu for controlling operation of said audio . . . audio display main menu for displaying the graphic representation of said output audio . . .”--column 33, line 24).

With respect to dependent claim 3, Hickey discloses “which includes a device for storage of digital representations of a plurality of works” (“disc memory means contained within said personal computer for storing media inventory . . .”--column 29, line 36).

With respect to dependent claim 4, Hickey discloses “which includes circuitry for writing a list to the storage device” (“processor means contained within said personal computer for executing said computer programs . . .”--column 29, line 40).

Art Unit: 2776

With respect to dependent claim 5, Hickey discloses “which includes circuitry for modifying a selected list” (“in the component list in the lower menu . . . deselect that component by changing the letters . . .”--column 27, line 61).

With respect to dependent claim 6, Hickey discloses “circuitry for presenting the works on the modified list to the audio output device” (“select audio display is scrolled into the touch pad of the first column . . . the menu of fig.12 is displayed . . .”--column 28, line 18).

With respect to dependent claim 7, Hickey discloses “which includes a video output device” (“the color display screen . . .”--column 6, line 45).

With respect to dependent claim 8, Hickey discloses “wherein the circuitry includes a programmable processor” (“processor means contained withing said personal computer . . . said plurality of functional menus generated by said computer programs . . .”--column 32, line 39).

With respect to dependent claim 9, Hickey discloses “includes a control program, executing by the processor, for providing information on the visual output device as to selected characteristics of at least some of the works” (“audio visual components air-time program listing, media content and media graphic information, said computer programs functioning to load . . . into said disc memory means . . .”--column 31, line 66).

With respect to independent claim 10, Hickey discloses “commands for reading and storing at least one digitized work; commands for building a displayable list of works” (“selecting and retrieving of information about media name . . . and digitized media graphic images . . . audio visual components, storing and recalling of a list of selections . . .”--column 31, line 13).

Art Unit: 2776

With respect to dependent claim 11, Hickey discloses “commands for presenting a list of works for review” (“a list of selections for control of said audio-visual components to be performed . . .”--column 31, line 23).

With respect to dependent claim 12, Hickey discloses “includes commands for modifying a selected list” (“menu operation is done . . . components are added, deleted . . .”--column 28, line 7).

With respect to dependent claim 13, this claim is rejected on grounds corresponding to the arguments given above for rejected dependent claim 6. In dependent claim 13, Applicant claims a control element which contains means corresponding to the steps of the system of rejected dependent claim 6.

With respect to dependent claim 14, Hickey discloses “commands for reading a digitized work from a wireless source” (“now available with the industry standard Control-S IR wireless remote control protocol . . .”--column 2, line 52).

With respect to dependent claim 15, Hickey discloses “commands for reading a digitized work from a local storage medium coupled to the input device” (“touch pad may be used to set up . . . will be in digital computer compatible format, and when received, they will be automatically loaded into the data base . . .”--column 25, line 66).

With respect to dependent claim 16, Hickey discloses “commands for building an inventory of digitally stored works” (“means for storing and retrieving media information . . .”--column 29, line 54).

Art Unit: 2776

With respect to dependent claim 17, Hickey discloses “commands for determining if an authorizing credit has been established” (“TV or radio program listing information that would be used by this new A-V system . . . time-warner cable, United Video . . . which would provide request for and receipt . . .”--column 8, line 36).

With respect to dependent claim 18, Hickey discloses “commands for writing at least one work on a selected list to a portable digital storage medium” (“storing and recalling a list . . . media comprises CD discs . . .”--column 29, line 68).

With respect to dependent claim 19, Hickey discloses “commands are storable on a portable digital storage medium” (“storing and recalling a list . . . media comprises CD discs . . .”--column 29, line 68).

With respect to independent claim 20, this claim is rejected on grounds corresponding to the arguments given above for rejected dependent claim 13. In independent claim 20, Applicant claims a terminal which contains means corresponding to the steps of the control element of rejected dependent claim 13. Hickey discloses “circuitry for receiving digital representations of works from a remote source” (“controlled with a now familiar IR remote controller . . .”--column 2, line 53).

With respect to dependent claim 21, Hickey discloses “includes devices for storing at least one of the works received from the remote source” (“IR remote controller . . . store a limited list of functions . . .”--column 2, line 54).

Art Unit: 2776

With respect to dependent claim 22, this claim is rejected on grounds corresponding to the arguments given above for rejected dependent claim 17. In dependent claim 22, Applicant claims a terminal which contains means corresponding to the steps of the control element of rejected dependent claim 17.

With respect to dependent claim 23, this claim is rejected on grounds corresponding to the arguments given above for rejected dependent claim 17. In dependent claim 23, Applicant claims a terminal which contains means corresponding to the steps of the control element of rejected dependent claim 17. Hickey discloses “a designation of at least one work can be added to the list” (“data acquisition, initialization . . . of a list of selections for control . . .”--column 31, line 121).

With respect to dependent claim 24, Hickey discloses “wherein the receiving circuitry is adapted to interconnect to a wired, at least in part, communications network” (“A-V System . . . might be via an interconnect to one of the interactive TV services . . .”--column 8, line 38).

With respect to dependent claim 25, Hickey discloses “a user operable input device for specifying a plurality of works” (“a user touches the screen, the software can detect if a user selection has been made . . .”--column 10, line 36) “circuitry for receiving from a source at least one specified work in a discontinuous format” (“permits the software to present option menus to the user for touch activation . . .”--column 9, line 63) “control circuitry coupled to the input device and the circuitry for receiving, wherein the control circuitry is adapted to create a visibly displayable sequence of the selected works” (“the touch screen capability permits the computer

Art Unit: 2776

software to display user options . . .”--column 10, line 36) “elements for storing commands enabling a user to modify the displayable sequence” (“only the selections are displayed at any one time, so that as user selections and decisions are made on a screen . . .”--column 10, line 50).

With respect to dependent claim 26, this claim is rejected on grounds corresponding to the arguments given above for rejected dependent claim 17. In dependent claim 26, Applicant claims an apparatus which contains means corresponding to the steps of the control element of rejected dependent claim 17.

With respect to dependent claim 27, this claim is rejected on grounds corresponding to the arguments given above for rejected dependent claim 18. In dependent claim 27, Applicant claims an apparatus which contains means corresponding to the steps of the control element of rejected dependent claim 18.

With respect to dependent claim 28, this claim is rejected on grounds corresponding to the arguments given above for rejected dependent claim 19. In dependent claim 28, Applicant claims an apparatus which contains means corresponding to the control element of the system of rejected dependent claim 19.

With respect to dependent claim 29, this claim is rejected on grounds corresponding to the arguments given above for rejected dependent claim 17. In dependent claim 29, Applicant claims an apparatus which contains means corresponding to the control element of the system of rejected dependent claim 17.

Art Unit: 2776

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,550,575 08/96 West et al. 348/5.5

Viewer discretion television program control system.

5,586,235 12/96 Kauffman 707/500

Interactive multimedia system and method.

5,583,922 12/96 Davis et al. 379/96

Telecommunication system for automatic switching between voice and visual data communications using forms.

5,428,694 06/95 Betts et al. 382/317

Data processing system and method for forms definition, recognition and verification of scanned images of document forms.

5,148,520 09/92 Morgan 395/148

Determining the locations of the contents of bordered areas of a generic form.

Art Unit: 2776

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703)-308-9051 (**formal** communications intended for entry),

Or:

(703)-305-9724 (**informal** communications labeled **PROPOSED** or **DRAFT**).

Hand-delivered responses should be brought to:

Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to

Alford Kindred, whose telephone number is (703)-305-3802 and can normally be reached Monday-Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached at (703)-305-4709.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)-305-3900.


ANTON FETTING
PRIMARY EXAMINER

Attachment _____

The drawings submitted with this application were declared informal by the applicant. Accordingly they have not been reviewed by a draftsperson at this time. When formal drawings are submitted, the draftsperson will perform a review.

Direct any inquires concerning drawing review to the Drawing Review Branch (703) 305-8404.